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KENT, C EXAMINER

35M1/0616

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ART UNIT	PAPER NUMBER
3504	8

DATE MAILED: 06/16/94

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined  Responsive to communication filed on 5/16/94  This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s),        days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned: 35 U.S.C. 133

Part I. THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1.  Notice of References Cited by Examiner, PTO-892.
2.  Notice re Patent Drawing, PTO-948.
3.  Notice of Art Cited by Applicant, PTO-1449.
4.  Notice of Informal Patent Application, Form PTO-152.
5.  Information on How to Effect Drawing Changes, PTO-1474.
6.  \_\_\_\_\_

Part II SUMMARY OF ACTION

1.  Claims 1-21 are pending in the application.

Of the above, claims 16-20 are withdrawn from consideration.

2.  Claims \_\_\_\_\_ have been cancelled.

3.  Claims \_\_\_\_\_ are allowed.

4.  Claims 1-5, 7-15 and 21 are rejected.

5.  Claims 6 are objected to.

6.  Claims \_\_\_\_\_ are subject to restriction or election requirement.

7.  This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8.  Formal drawings are required in response to this Office action.

9.  The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are  acceptable.  not acceptable (see explanation or Notice re Patent Drawing, PTO-948).

10.  The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_ has (have) been  approved by the examiner.  disapproved by the examiner (see explanation).

11.  The proposed drawing correction, filed on \_\_\_\_\_, has been  approved.  disapproved (see explanation).

12.  Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has  been received  not been received  been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_

13.  Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14.  Other

*C. Kent*

EXAMINER'S ACTION

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The following office action is in response to patent examination application SN 08/056,986 filed on 05/04/93.

RESTRICTION REQUIREMENT

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-15 and 21, drawn to a composite masonry block and a retaining wall structure, classified in Class 52, subclass 561.

II. Claims 16-18, drawn to a block mold assembly, classified in Class 249, subclass 52.

III. Claims 19-20, drawn to a method of using a block mold assembly, classified in Class 264, subclass 228.

Inventions of Group II and Group I are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (M.P.E.P. § 806.05(g)). In this case the product as claimed can be made by

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another and materially different apparatus such as a standard two-piece mold.

Inventions of Group III and Group II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (M.P.E.P. § 806.05(e)). In this case the process as claimed can be practiced by another materially different such as a block mold having a completely different shape.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with John J. Gresens on 06/07/94, a provisional election was made with traverse to prosecute the invention of Group I, claims 1-15 and 21. Affirmation of this election must be made by applicant in responding to this Office action. Claims 16-20 are withdrawn

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from further consideration by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention.

**PROVISIONAL REJECTION, OBVIOUSNESS DOUBLE PATENTING**

Claims 1-5, and 8-15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 and 10-16 of copending application Serial No. 07/957,598. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only differences are found in Forsberg, U.S. Patent 4,914,876, which discloses blocks having legs angled toward the front of the block for improved anchoring of the block in soil or aggregate, and retaining walls built from blocks of different measurements front to back ; the blocks of the top layer being of shorter dimension for finishing purposes (see Figs. 26 and 28 for angled legs and Figs 18 and 24 for different sized blocks). For the reasons given above, it would have been obvious at the time the invention was made for a person having ordinary skill in the art to provide the forward angled legs and shorter top blocks to the blocks and retaining wall structure of 07/957,598.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

**SPECIFICATION- 35 U. S. C. 112 OBJECTIONS FIRST PARAGRAPH**

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to provide an adequate written description of the invention. The claimed matrix comprising "tie backs positioned between the blocks of the upper and lower courses" is not described in the specification nor shown in the drawings.

Claim 12 is rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

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**STATEMENT OF STATUTORY BASIS - 35 U. S. C. 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --  
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**CLAIMS - 35 U. S. C. 102 REJECTIONS**

Claim 21 is rejected under 35 U.S.C. § 102(b) as being anticipated by Forsberg, U.S. Patent Number 4,914,876. Forsberg '876 (Fig. 23) teaches a method of building a retaining structure having blocks of an upper course shorter in front to rear surface dimension than the blocks of a lower course wherein the blocks meet the specific requirements of the claim.

**STATEMENT OF STATUTORY BASIS - 35 U. S. C. 103**

The following is a quotation of 35 U.S.C. § 103 that provides the basis for rejection citing obviousness as set forth in this Office Action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that

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the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

CLAIMS - 35 U. S. C. 103 REJECTIONS

Claims 1-5, 7-11, 13-15 and 21 are rejected under 35 U.S.C. § 103 as being unpatentable over Forsberg, U.S. Patent Number 4,914,876 in view of Italy 709,599. Forsberg '876 teaches a composite masonry block having top and bottom surfaces adjoined by first and second side surfaces and front and back surfaces, wherein said block back surface comprises first and second legs extending beyond the first and second side surface planes respectively, wherein the first and second legs angle toward the front surface, and pins protruding from said top surface adapted to fit within recesses on said bottom surface of an adjacent overlying block thereby providing an engagement means between blocks. Forsberg '876 lacks an inset on said side surfaces spanning from said top surface to said bottom surface. Italy '599 teaches a block having a pair of protrusions (4) located on

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a top surface adjacent insets (8) located on side surfaces providing an engagement means between one of said blocks and an adjacent overlying block of similar construction. For providing a more efficient and economical engagement means, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to substitute the protrusion and inset engagement means of Italy '599 for the pin and recess engagement means of Forsberg '876.

Regarding claim 2, Forsberg '876 teaches a block having an open central portion.

Regarding claim 3, Forsberg '876 teaches a curved front surface. Forsberg '876 lacks a planar front surface. Blocks having various decorative front surfaces (including planar, curved and faceted) are well known in the art. For aesthetic purposes, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to provide the block of Forsberg '876 with a planar front surface.

Regarding claim 4, see rationale of rejection of claim 3 for providing a faceted front surface to the block of Forsberg '876.

Regarding claim 5, Forsberg '876 teaches a block having a front surface which is outwardly curving.

Regarding claim 8, Forsberg '876 teaches a retaining wall comprising blocks of claims 1-5. See rejection of claim 1.

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Regarding claim 7, (note: this claim should be renumbered to reflect its dependence upon claim 8) the actual dimensions of the insets are not given by Italy '599. However, this dimension is viewed as dependent on the actual use and corresponding requirements found through engineering methods and would have been obvious at the time the invention was made to a person having ordinary skill in the art.

Regarding claim 9, Italy '599 teaches two or more courses wherein the blocks of the upper course comprise insets which are seated on protrusions of the block of a lower course.

Regarding claim 10, Forsberg '876 teaches a supporting matrix (353).

Regarding claim 11, Forsberg '876 teaches blocks of said upper course being smaller in front to rear surface dimension than said blocks of said lower course (see Fig. 23).

Regarding claim 13, Forsberg '876 teaches a continuous webbing (353) between courses.

Regarding claim 14, Forsberg '876 teaches a substantially vertical wall (see Fig. 1).

Regarding claim 15, Forsberg '876 teaches a wall et back at an angle (see Figs. 23 and 25).

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ALLOWABLE SUBJECT MATTER

Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art of record fails to anticipate or render obvious the limitation regarding the protrusions having oblong sections joined by a narrower joining section, enabling the construction of curved wall structures.

REFERENCES

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Janopaul, Jr. teaches a setback wall.

Any inquiry concerning this communication should be directed to Christopher Kent at (703) 308-2497.

*Christopher Kent*  
Christopher Kent  
June 9, 1994

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